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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/780,237	02/17/2004	Brian Jones	60001.0289US01/MS305239.1	9655

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EXAMINER

HILLERY, NATHAN

ART UNIT PAPER NUMBER

2176

DATE MAILED: 06/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/780,237	Applicant(s) JONES ET AL.	
	Examiner Nathan Hillery	Art Unit 2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5/8/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: Application filed on 2/17/04.
2. Claims 1 – 20 are pending in the case. Claims 1, 15, and 18 are independent.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1 – 20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1 – 20 have no practical application as claimed because there is no physical transformation and no production of a concrete, useful and tangible result.

- a. The result of the claimed invention remains in the abstract and is not made available to the user; thus it is not tangible.

- b. The claims appear to be in the preliminary stages and fall short of the disclosed practical utility. In other words, the claims fail to fulfill and/or reflect the specific, substantial, and credible utility sought by the disclosed invention, and thus do not produce a useful result.

5. Consequently, the claims are nonstatutory. The claims simply recite locating and determining data and/or information with no concrete, useful, tangible result.

6. Further, to expedite a complete examination of the instant application the claims rejected under 35 U.S.C. 101 (nonstatutory) above are further rejected as set forth below in anticipation of applicant amending these claims to place them within the four statutory categories of invention.

Double Patenting

7. Applicant is advised that should claims 1 – 5 be found allowable, claims 15 – 17 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

9. Claims 1 – 20 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Microsoft (Overview of WordprocessingML).

10. **Regarding independent claim 1**, Microsoft teaches that if you save a Word document with the .xml extension, Windows will treat the file like any other XML file. Adding the mso-application processing instruction specifies Word as the preferred application for processing the file (p 3, first paragraph), which is equivalent to **applying Extensible Markup Language (XML) markup to a computer-generated document**. It should be noted that the Word document of Microsoft is equivalent to the claimed **computer-generated document**.

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11. Microsoft teaches that you'll be introduced to how WordprocessingML stores VBA code and OCX controls. You'll also see how Word ensures that software can detect whether these components are present in the document (p 27, Macros and Components, first paragraph), which is equivalent to the claimed **locating an executable code embedded in the document**. It should be noted that the VBA code of Microsoft is equivalent to the claimed **executable code**.

12. Microsoft teaches that two attributes of the wordDocument element are used to indicate the presence of the VBA code and OCX controls. (p 27, Macros and Components, second paragraph), which is equivalent to the claimed **applying an attribute to a root level element of the XML markup for notifying a subsequent application of the presence of the embedded executable code**. It should be noted that the wordDocument element of Microsoft is equivalent to the claimed **root level element of the XML markup** as illustrated in the Table on page 2.

13. **Regarding dependent claim 2**, Microsoft teaches that you'll be introduced to how WordprocessingML stores VBA code and OCX controls. You'll also see how Word ensures that software can detect whether these components are present in the document (p 27, Macros and Components, first paragraph), which is equivalent to the claimed **passing the document to the subsequent application; parsing the XML markup by the subsequent application to locate the attribute applied to the root level element of the XML markup applied to the document**.

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14. **Regarding dependent claim 3**, Microsoft teaches that if the attribute is present, indicating that macros are supposed to be present, and Word doesn't find a docSuppData element before it finds the body element, Word will not load the document (p 27, last sentence), which is equivalent to the claimed **if the attribute is located by the subsequent application, rejecting the document as corrupted by the embedded executable code**. It should be noted that the Word of Microsoft is equivalent to the claimed **subsequent application**.

15. **Regarding dependent claim 4**, Microsoft teaches that if the attribute, used to indicate that macros are present in the document, is set to "no", then Word won't load a document that has a docSuppData element (p 27, last paragraph), which is equivalent to the claimed **if the attribute is located, determining whether the embedded executable code associated with the attribute requires rejection of the document, and if not, continuing to parse the XML markup of the document by the subsequent application**. It should be noted that the docSuppData element of Microsoft is equivalent to the claimed **embedded executable code** and that the Word of Microsoft is equivalent to the claimed **subsequent application**.

16. **Regarding dependent claim 5**, Microsoft teaches that if the attribute, used to indicate that macros are present in the document, is missing, then Word won't load a document that has a docSuppData element (p 27, last paragraph), which is equivalent to the claimed **parsing the XML markup by the subsequent application includes**

locating the executable code embedded in the document; determining by the subsequent application whether an attribute is present for notifying the subsequent application of the presence of the executable code; and if the attribute is not present, then rejecting the executable code. It should be noted that the docSuppData element of Microsoft is equivalent to the claimed **embedded executable code** and that the Word of Microsoft is equivalent to the claimed **subsequent application**.

17. **Regarding dependent claim 6**, Microsoft teaches that the macrosPresent attribute of the wordDocument element is used to indicate the presence of the VBA code (p 27, last two paragraphs), which is equivalent to the claimed **the attribute is a macros present attribute for indicating the presence of VBA code in the document**.

18. **Regarding dependent claim 7**, Microsoft teaches that if the attribute is set to "yes", then it indicates that macros are supposed to be present (p 27, last paragraph), which is equivalent to the claimed **the macros present attribute has a value of "yes" where an XML markup element is in the document containing the VBA code**.

19. **Regarding dependent claim 8**, Microsoft teaches that the macrosPresent attribute is used to indicate that macros are present in the document. If the attribute is set to "no", then it indicates that macros are not supposed to be present (p 27, last

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paragraph), which is equivalent to the claimed **the macros present attribute has a value of “no” indicating that no XML element is in the file containing the VBA code.**

20. **Regarding dependent claim 9**, Microsoft teaches that the second attribute is the embeddedObjectPresent attribute, which indicates that an OCX control may have been used in the document (p 28, second paragraph), which is equivalent to the claimed **the attribute is an embedded object present attribute indicating the presence of one or more OLE objects in the document.** It should be noted that an OCX control is simply an OLE custom control, which is equivalent to an OLE object as explained in Microsoft (p 27, first paragraph).

21. **Regarding dependent claim 10**, Microsoft teaches that the second attribute is the embeddedObjectPresent attribute, which indicates that an OCX control may have been used in the document. If the attribute is set to "yes", then it indicates that macros are supposed to be present (p 28, second paragraph), which is equivalent to the claimed **the embedded object present attribute has a value of “yes” indicating the presence of at least one XML element in the document containing data associated with an OLE object.**

22. **Regarding dependent claim 11**, Microsoft teaches that the second attribute is the embeddedObjectPresent attribute, which indicates that an OCX control may have

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been used in the document. If the attribute is set to "no", then it indicates that macros are not supposed to be present (p 28, second paragraph), which is equivalent to the claimed **the embedded object present attribute has a value of "no" indicating that there are no XML elements in the file containing data associated with an OLE object.**

23. **Regarding dependent claim 12**, Microsoft teaches that the second attribute is the embeddedObjectPresent attribute, which indicates that an OCX control may have been used in the document (p 28, second paragraph), which is equivalent to the claimed **the attribute is an OCX present attribute indicating the presence of OCX objects in the document.**

24. **Regarding dependent claim 13**, Microsoft teaches that the second attribute is the embeddedObjectPresent attribute, which indicates that an OCX control may have been used in the document. If the attribute is set to "yes", then it indicates that macros are supposed to be present (p 28, second paragraph), which is equivalent to the claimed **the OCX present object attribute has a value of "yes" indicating the presence of at least one XML element in the document containing data associated with an OCX object.**

25. **Regarding dependent claim 14**, Microsoft teaches that the second attribute is the embeddedObjectPresent attribute, which indicates that an OCX control may have

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been used in the document. If the attribute is set to "no", then it indicates that macros are not supposed to be present (p 28, second paragraph), which is equivalent to the claimed **the OCX present object attribute has a value of "no" indicating that there are no XML elements in the file containing data associated with an OCX object.**

26. **Regarding claims 15 – 20**, the claims incorporate substantially similar subject matter as claims 1 – 5, and are rejected along the same rationale.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan Hillery whose telephone number is (571) 272-4091. The examiner can normally be reached on M - F, 10:30 a.m. - 7:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R. Herndon can be reached on (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'D. Hutton', with a stylized flourish at the end.

Doug Hutton
Primary Examiner
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NH